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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,429	12/27/2001	Aiko Okajima	016907-1353	1561

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FOLEY AND LARDNER
3000 K Street NW
Washington, DC 20007

EXAMINER

PARK, CHAN S

ART UNIT PAPER NUMBER

2625

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,429

Applicant(s)

OKAJIMA, AIKO

Examiner

CHAN S. PARK

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-14 and 16 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

RECEIVED
DOUGLAS Q. TRAN
PRIMARY EXAMINER

DOUGLAS Q. TRAN
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-894)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/2/06 has been entered. Currently, **claims 1, 3-6 and 8-16** are pending.

Claim Objections

2. Claims 1, 5, 6, 10, 11 and 16 are objected to because of the following informalities:

Claim 1, line 6, "the printing job" should be -- a printing job --;

Claim 5, line 2, "a special paper sheet" should be -- the special paper sheet --;

Claim 5, line 3, "a special paper sheet" should be -- the special paper sheet --;

Claim 5, line 4, "a printing job including special printing" should be -- the printing job including the special printing --;

Claim 6, line 2, "data input" should be -- input data --;

Claim 6, line 2, "a printing job" should be -- printing jobs --;

Claim 6, line 4, "the printing job" should be -- the printing jobs --;

Claim 6, line 5, "print data" should be -- the printer --;

Claim 6, line 7, "printing jobs" should be -- the printing jobs --;

Art Unit: 2625

Claim 6, lines 12-13, "the printing job" should be -- a printing job --;

Claim 6, line 16, "special printing" should be -- the special printing --;

Claim 10, line 3, "a special paper sheet" should be -- the special paper sheet --;

Claim 10, line 4, "a special paper sheet" should be -- the special paper sheet --;

Claim 10, line 5, "a printing job including special printing" should be -- the printing job including the special printing --;

Claim 11, line 9, "special printing" should be -- the special printing --;

Claim 15, line 3, "one or more sheets of paper" should be -- "one or more pages of the printing jobs";

Claim 16, line 1, "execution of a printing job" should be -- the execution of the printing job --; and

Claim 16, line 2, "a job selection made by a user is received" should be -- the input section receives a selection made by the user for printing the printing job --.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 5, 6, 8, 1-12, 14 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Ban U.S. Patent No. 6,332,170.

3. With respect to claim 1, Ban discloses a printer comprising:

a receiving section (NIC 16 in fig. 2) which receives printing jobs (col. 2, lines 1-4);

a storage section which stores the received printing jobs (col. 3, lines 39-40);

a printing section which executes the printing jobs extracted from the storage section (fig. 4);

a determining section which determines whether a page index of each page or a job index of a printing job (specific attribute information in col. 2, line 5) which has been received by the receiving section includes information on special printing (col. 4, lines 41-53);

a display section which displays a list of the printing jobs that are determined as including the special printing in the page index or the job index by the determining section (fig. 4 & col. 2, lines 26-34);

an input section which accepts a printing job selected by a user from the displayed list (fig. 4); and

a control section which extracts from the storage section the printing job selected by the user, and causes the printing section to execute it (col. 4, lines 19-38).

4. With respect to claim 3, Ban discloses the printer according to claim 1, wherein the special printing is printing on a special paper sheet other than a normal paper sheet (col. 4, lines 45-53).

5. With respect to claim 14, Ban discloses the printer according to claim 1, wherein the control section prevents the printing section from printing any of the received printing jobs that include information on the special printing that are stored in the storage section, until the input section receives a selection made by the user for printing one or more of the received printing jobs that include information on the special printing (fig. 7 & page 8, lines 1-4 of the Remark filed on 6/2/06).

6. With respect to claim 16, Ban discloses the printer according to claim 1, wherein the execution of the printing job including the special printing is prevented unless the input section receives a selection made by the user for printing the printing job (fig. 7 & page 8, lines 1-4 of the Remark filed on 6/2/06).

7. With respect to claim 6, arguments analogous to those presented for claim 1, are applicable. Referring to fig. 1, Ban discloses that the printer is a network printer which receives the printing jobs sent from a terminal device.

8. With respect to claim 8, arguments analogous to those presented for claim 3, are applicable.

9. With respect to claim 11, arguments analogous to those presented for claim 1, are applicable. It is noted that the printer of Ban displays a list of the special printing jobs without executing the printing jobs (col. 3, line 59 – col. 4, line 18).

10. With respect to claim 12, arguments analogous to those presented for claim 3, are applicable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ban as applied to claim 3 above, and further in view of Hunter et al. U.S. Patent No. 6,071,030 (hereinafter Hunter).

11. With respect to claim 4, Ban discloses the printer according to claim 3 wherein the printer includes a manual feed tray in case of the special printing job. Ban, however, does not disclose explicitly disclose the printer for printing the print data on a tab paper sheet.

Hunter, the same field of the manual feed printing art (col. 1, lines 18-20), discloses a printer for printing print data on a manual fed tab paper (fig. 11).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the tab paper printing capability on the printer of Ban.

The motivation/suggestion for doing so would have been to simply print the printing jobs including the tab paper printing jobs on the printer of Ban.

Therefore, it would have been obvious to combine Ban with Hunter to obtain the invention as specified in claim 4.

12. With respect to claims 9 and 13, arguments analogous to those presented for claim 4, are applicable.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ban as applied to claim 3 above, and further in view of Kanazawa et al. U.S. Patent No. 7,019,851 (hereinafter Kanazawa).

13. With respect to claim 4, Ban discloses the printer according to claim 3 wherein the printer includes a manual feed tray in case of the special printing job. Ban, however, does not explicitly disclose the printer including a sensor which senses absence of the special paper sheet in the paper feed section, wherein when the printing job including the special printing is selected by the user through the input section, the control section causes the display section to display absence of the special paper sheet, on condition that the sensor senses absence of the special paper sheet in the paper sheet section.

Kanazawa, the same field of endeavor of the manual feed printing art, discloses a printer comprising:

- a paper feed section which feeds the special paper to the printing section; and
- a sensor which senses absence of the special paper sheet in the paper feed section,

wherein when the printing job including the special printing is selected by the user through the input section, the control section causes the display section to display absence of the special paper sheet, on condition that the sensor senses absence of the special paper sheet in the paper sheet section (col. 15, lines 18-33).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the sheet detecting sensor of Kanazawa into the printer/copier of Ban.

The suggestion/motivation for doing so would have been to inform the user whether the special printing sheets are available to render the special printing job.

Therefore, it would have been obvious to combine Ban with Kanazawa to obtain the invention as specified in claim 5.

14. With respect to claim 10, arguments analogous to those presented for claim 5, are applicable.

Allowable Subject Matter

15. Claim 15 objected to as being dependent upon a rejected/objected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Moreover, the claim must be rewritten to overcome the objections, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

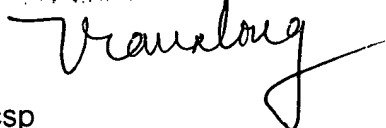
Contact Information

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DOUGLAS Q. TRAN
PRIMARY EXAMINER



csp
June 19, 2006

Chan S. Park
Examiner
Art Unit 2625

